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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/818,884	03/17/97	YAMAZAKI S	0756-1653

MM12/0901

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EXAMINER	
NGUYEN,D	
ART UNIT	**PAPER NUMBER**
2871	

DATE MAILED: 09/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/818,884	Yamazaki et al.
Examiner	**Group Art Unit**
Dung Nguyen	2871

☒ Responsive to communication(s) filed on *Jun 7, 1999* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-7, 9, 10, 17-24, 26, 27, and 30-50* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-7, 9, 10, 17-24, 26, 27, and 30-50* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *39*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicant's amendment dated 06/07/99 has been received and entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 9, 10, 17-20, 27, 30, 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, it is confusing and unclear whether the claimed second memory is the same one the first memory; for the purpose of examination, it is assumed that the first memory is referring to the correction memory.

Regarding claim 9, it is confusing and unclear which memory is "said memory" on line 2 referring to since base claim 7 has two "memory".

Regarding claim 17, it is confusing and unclear whether the claimed second memory (line 8) is the same one the first memory (line 7); for the purpose of examination, it is assumed that the first memory is referring to the correction memory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 6, 21, 22, 26, 31, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's submitted prior art Yamazaki '858, in view of Applicant's submitted prior art Sawatsubashi '301.

The above claims are anticipated by Yamazaki's figures 3 and 8 which together disclose an LCD device comprising:

- two insulating glass substrates with a liquid crystal layer inherently interposed therebetween;
- one of the insulating substrate (50) having formed thereon:
    - an active matrix circuit (fig. 8) including at least one TFT (13 & 22, figure 3);
    - a driving circuit (1) including at least one TFT (CTFT, fig. 8) for driving the active matrix circuit; wherein the TFTs in this circuit and in the active matrix circuit are formed from the same process, thus exhibited the same structure and formed from a common semiconductor film formed over the insulating substrate (figure 8; col. 11, lines 7+);
    - a semiconductor control IC (4) mounted on the substrate for controlling the driving circuit and connected to the latter by COG.

However, Yamazaki does not disclose an extended portion on one of the insulating glass substrates for the semiconductor control IC to be formed thereon while the driving circuit is covered by the counter substrate. Sawatsubashi does disclose the driving circuit (112, 113) is covered by the counter substrate (col. 6, ln. 30+) and an extended portion on TFT substrate (101)

beyond one side edge of the counter substrate (102) for forming the semiconductor IC (i.e, 115)(see Fig. 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an extended portion to Yamazaki's substrate and cover driving circuit as shown in the Sawatsubashi's reference in order to minimize a display device (col. 3, ln. 10).

Double Patenting

5. Claim 43 is rejected under 35 U.S.C. 101 as being a substantial duplicate of claim 41. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-7, 9, 10, 17-24, 26, 27, 30-50 are rejected under the judicially created doctrine of double patenting over claims 1, 3, 12, 13 and 17 of U. S. Patent No. 5,889,291 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The subject matter claimed in the instant application pertains to the embodiment in figures 9, 10A, 10B, 11 and 12 and the accompanying relevant text, of both the patent and the instant application. The various additionally claimed limitations in the instant application, while not asserted in claims 1, 3, 12, 13 and 17 per se, are fully disclosed in the patent (Specification, Embodiment 4) and covered by claims 1, 3, 12, 13 and 17 in the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Dung Nguyen whose telephone number is (703) 305-0423. The fax phone number for this Group is (703) 308-7726.

Any information of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0956.

DN

William L. Sikes

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